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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,537	02/05/2004	David Tsai	04-01-2174	5417

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EXAMINER

PONNALURI, PADMASHRI

ART UNIT PAPER NUMBER

1639

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/772,537	<b>Applicant(s)</b> TSAI, DAVID	
	<b>Examiner</b> Padmashri Ponnaluri	<b>Art Unit</b> 1639	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 November 2005.  
 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 15 is/are rejected.  
 7) ☒ Claim(s) 15 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

NOTE the change of examiner in this application.

1. The amendment and response file don 11/1/05 have been fully considered and entered into the application.
2. Claims 1-14 and 16-19 have been canceled by the amendment filed on 11/1/05.
3. Claim 15 is currently pending in this application.

#### ***Claim Objections***

4. Claim 15 is objected to because of the following informalities: a sequence identifiers must be present in the claimed invention.

Correction is required.

#### ***Withdrawn Claim Rejections***

5. The rejection of claim 11 35 U.S.C. 112, second paragraph, set forth in the previous office action has been withdrawn in view of cancellation of claims.
6. The New matter rejection of claims 16 and 19 under 35 U.S.C. 112, first paragraph, set forth in the previous office action has been withdrawn in view of cancellation of claims.
7. The written description of claims 11, 15-16 and 19, set forth in the previous office action has been withdrawn in view of cancellation of claims 11, 16, and 19.
8. The scope enablement rejection of claims 11, 15, 16, 19, set forth in the previous office action has been withdrawn in view of cancellation of claims 11, 16, and 19.

#### ***Maintained Claim Rejections***

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9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. The rejection of claims 15-16 and 19 under 35 U.S.C. 102(a,b) as being anticipated by Brown et al., Eur. J. Biochem. Vol. 205 pages 321-331 (1992) alone and if necessary further in view of the specification as evidence of inherent properties, has been maintained for the reasons of record.

***Response to Arguments***

11. Claims 15-16 and 19 are rejected under 35 U.S.C. 102(a,b) as being anticipated by Brown et al., Eur. J. Biochem. Vol. 205 pages 321-331 (1992) alone and if necessary further in view of the specification as evidence of inherent properties. .

The claims are directed to a “fetuin polypeptide” **comprising** . .  
an amino acid sequence of His X1 Phe Ser X2 Val Ala Ser Val Glu (X1 and X2 being any amino acid) (e.g. claim 16) wherein said sequence is His Ser Phe Ser Gly Val Ala Ser Val Glu (e.g. claims 15 and 19).

The fetuin polypeptide :

- a. is “for the treatment of colon and prostate cancer” (claim 16: intended use language) or
- b. “causes apoptosis in colon and prostate cancer cells” (claim 15: inherent property flowing from peptide structure)

Brown et al. disclose “fetuin polypeptide” (e.g. pig fetuin) comprising His Ser Phe Ser Gly Val Ala Ser Val Glu (e.g. see fig. 5 page 327, line 9 from bottom: amino acid number 300-309 ). Intended use limitations (e.g. “for the treatment of colon and prostate cancer”) are not afforded patentable weight in compound/composition claims; and/or the reference peptide which

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is a decapeptide clearly within the scope of the presently claimed invention MUST inherently “cause apoptosis in colon and prostate cancer cells” (e.g. see present specification for evidence of inherency).

12. *Applicant's arguments filed on 11/1/05 regarding the rejection of claim 15 over Brown et al, have been fully considered but they are not persuasive.*

*Applicants traverse the rejection. Applicants assert that Brown reference would not enable one of ordinary skill in the art to make and carry out the Applicants claimed invention without undue experimentation.*

*Applicants assertions have been considered and are not persuasive. The instant claim recites ‘feutin polypeptide comprising His Ser Phe Ser Gly Val Ala Ser Val Glu, wherein said polypeptide causes apoptosis in colon and prostate cancer cells.’ And the reference (Brown et al) discloses the amino acid and nucleic acid sequence of the feutin polypeptide. Thus, the reference clearly anticipates the claimed feutin polypeptide.*

*Applicants seem to be arguing that Brown et al teach 347 amino acid long feutin polypeptide, whereas Applicants have isolated and claimed a decapeptide. Applicants arguments have been considered and are not persuasive, since the instant claim polypeptide is considered as open ended because of recitation of ‘comprising’ (comprising an amino acid sequence of His Ser Phe Ser Gly Val Ala Ser Val Glu).’ The claimed polypeptide is open to other amino acids and the length of the instant claimed polypeptide is not limited to 10 amino acids as in applicants arguments.*

*In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., decapeptide)*

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*are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).*

*[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property, which is inherently present in the prior art, does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). >In In re Crish, 393 F.3d 1253, 1258, 73 USPQ2d 1364, 1368 (Fed. Cir. 2004)*

*The rejection of record has been maintained for the reasons of record.*

### **Conclusion**

13. No claims are allowed.

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Padmashri Ponnaluri whose telephone number is 571-272-0809. The examiner can normally be reached on Monday through Friday between 7 AM and 3.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
PADMASHRI PONNALURI  
PRIMARY EXAMINER

Padmashri Ponnaluri  
Primary Examiner  
Art Unit 1639

26 January 2006